

**REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

**Status of Claims:**

Claims 11 and 12 are currently being cancelled.

Claims 1 and 14-16 are currently being amended.

No claims are currently being added.

This amendment and reply amends and cancels claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending and canceling the claims as set forth above, claims 1-10 and 13-17 are now pending in this application.

**Claim Rejections – 35 U.S.C. § 112, 1<sup>st</sup> Paragraph:**

In the Office Action, claims 12, 14 and 16 were rejected under 35 U.S.C. § 112, 1st Paragraph, as failing to comply with the enablement requirement, for the reasons set forth on pages 2 and 3 of the Office Action. In reply, claims 12 and 16 have been amended to remove the offending word “slot.” (whereby the features of claim 12, now canceled, have been incorporated into claim 1). Also, with respect to certain features recited in claim 16 and discussed at the top of page 3 of the Office Action, please refer to Figure 3 of the drawings and page 7, lines 13-20 of the specification, which states that “an antenna 16A and a dielectric member 17A on the upper casing or an antenna 16B and a dielectric member 17B on the lower casing.” The disposition of the antenna on either “a back surface of the upper casing or a front surface of the lower casing” can clearly be seen in Figure 3 of the drawings.

Accordingly, presently pending claims 1 (which now includes the features of claim 12, now canceled)) and 16 fully comply with 35 U.S.C. § 112, 1st Paragraph.

With respect to the 35 U.S.C. § 112, 1st Paragraph rejection of claim 14, that claim has been amended based on the paragraph bridging pages 7 and 8 of the specification, whereby presently pending claim 14 fully complies with 35 U.S.C. § 112, 1st Paragraph.

**Claim Objections:**

In the Office Action, claims 11, 15 and 16 were objected to because “the joint 29 is provided on the antenna 16, not on the dielectric member 28, 30 or 31.” By way of this amendment and reply, claims 1 (which now includes the features of claim 11, now canceled), 15 and 16 have been amended based on the Examiner’s correct analysis of the disposition of the joint and the antenna.

**Claim Rejections – Prior Art:**

In the Office Action, claims 1, 5 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0142794 to Harano in view of U.S. Patent No. 5,907,307 to Bickert; claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0232628 to Ferm in view of U.S. Patent No. 6,615,026 to Wong; claims 3, 4 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harano in view of Bickert and further in view of Wong; claims 6, 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harano in view of Bickert and further in view of U.S. Patent No. 7,031,762 to Shoji et al.; claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Harano in view of Bickert and further in view of U.S. Patent No. 6,590,544 to Filipovic; and claims 11, 12 and 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Harano in view of Bickert and further in view of U.S. Patent No. 6,684,085 to Haruyama. These rejections are traversed with respect to the presently pending claims under rejection, for at least the reasons given below.

With respect to the rejection of claim 11, whereby presently pending independent claim 1 now includes the features of claims 11 and 12 (slightly rewritten to address the 112, 1<sup>st</sup> paragraph rejection and objection to those claims), presently pending independent claim 1 recites that the joint corresponds to a feeding section that feeds power to the antenna from the portable telephone when the antenna and the dielectric member are coupled together. Haruyama’s use of a rod 22 to provide a physical height of his small antenna 23 says nothing about whether or not his small antenna 23 is an active device (requiring power) or a passive device (not requiring power), and thus to assert that Haruyama’s rod operates not only as a physical structure but also as a power-providing conduit is clearly without basis, based on a reasonable interpretation of the purpose of Haruyama’s rod 22.

Accordingly, presently pending independent claim 1 is patentable over the cited art of record.

Furthermore, with respect to the rejection of dependent claim 5, that claims recites that the dielectric member has a curved surface on a side opposite to the antenna. As described on page 13 of the specification, the curved surface provides useful effects for passing a plane wave component into a vacuum space. The Office Action asserts that Figure 2 of Bickert et al. discloses a dielectric member having a curved surface, but this assertion is incorrect. Namely, Figure 2 of Bickert is a two-dimensional figure that is provided to show a dielectric member 12 and an antenna 10, whereby the curved "hatched" region in Figure 2 is not meant to signify a curved surface, but rather to signify that the dielectric member 12 extends throughout the square 8 (with presumably a flat surface). To infer a three-dimensional (curved) shape based on a two-dimensional drawing (Figure 2 of Bickert), without any basis in the text of Bickert (there is no none), is clearly improper.

Accordingly, dependent claim 5 is patentable over the cited art of record for these additional reasons.

With respect to the rejection of independent claim 13 over the combined teachings of Fehrm and Wong, the Office Action relies on Wong to teach a dielectric member positioned farther from where a palm of a user is located than an antenna is positioned with respect to the palm of the user, when the user is holding the portable telephone within the palm in order to operate the portable telephone. However, Wong's disposition of his dielectric member is within a housing of his mobile telephone at a middle section of his mobile telephone, as seen in Figure 1 of Wong, and thus Wong does not teach or suggest an antenna is mounted on a lower end of the lower casing on an outer surface of the lower casing, as recited in presently pending independent claim 13. Accordingly, to assert that Wong's disposition of his antenna and dielectric member within a housing of his mobile telephone at a middle section of his mobile telephone can be modified to be placed on an outside of his mobile telephone at a lower end of a lower casing of his mobile telephone, is clearly not something to be envisioned by a person of ordinary skill in the art, without hindsight knowledge of the claimed invention.

Note also that column 2, lines 64 et seq. describes that the purpose for having a dielectric material in front of the antenna 12 is because Wong also has a metallic surface 14 provided within the interior of his mobile phone, so as to maximize a shielding effect for the user, whereby metallic surface 14 is utilized to radiate electromagnetic waves radiated by the

antenna 12 into a widely scattered area. See column 3, lines 25-31 of Wong. Since Fehrm does not utilize such a scheme of having an antenna with a metallic surface, namely because Fehrm's antenna is provided an outer surface of his mobile telephone and thus does not have the transmission problems associated with transmitting electromagnetic waves from within a housing of a mobile telephone, it would not make sense to utilize the teachings of Wong into the mobile telephone of Fehrm.

Thus, since Fehrm and Wong cannot be combined in the manner suggested in the Office Action, independent claim 13 is patentable over the cited art of record.

With respect to the rejection of independent claim 16, that claim recites:

*wherein the antenna includes a joint provided on one end of the antenna and that is configured to be coupled to either a back surface of the upper or a front surface of the lower casing,*

*wherein, when the antenna and dielectric member are connected to the upper casing, the dielectric member is positioned farther away from a head of a user than the antenna is positioned with respect to the head of the user, when the user is operating the portable telephone, and*

*wherein, when the antenna and dielectric member are connected to the lower casing, the dielectric member is positioned farther from where a palm of a user is located than the antenna is positioned with respect to the palm of the user, when the user is holding the portable telephone within the palm in order to operate the portable telephone.*

In its rejection of claim 16, the Office Action merely refers to Figure 3, component 22, column 4, lines 46-50 and column 5, lines 19-27 of Haruyama for teachings the above features of claim 16. Applicants respectfully disagree. In particular, Figure 3 of Haruyama merely shows a small antenna 23 connected to a top portion of a mobile telephone, by way of a rod 22. Column 4, lines 46-50 of Haruyama describes that two terminals of a radiation section 2a are electrically connected to the mobile telephone, whereby this clearly implies that the antenna can only be connected to only one portion of the mobile telephone, such as seen in Figure 3 of Haruyama. Column 5, lines 19-27 of Haruyama describes Figure 3 of that reference, whereby a small antenna 23 is attached to a top area of a rod to define a physical height of the antenna. Again, this merely validates that Haruyama's antenna can only be connected to only one portion of the mobile telephone, that being at the top of his mobile telephone, as seen in Figure 3 of Haruyama.

Accordingly, since neither Bickert nor Harano makes up for these deficiencies of Haruyama (as acknowledged in the Office Action due to its reliance on Haruyama in rejecting claim 16), claim 16 is patentable over the cited art of record.

**Conclusion:**

Since all of the issues raised in the Office Action have been addressed in this Amendment and Reply, Applicants believe that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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